REMARKS/ARGUMENTS

This Amendment responds to the Office Action dated January 4, 2010 in which the Examiner rejected claims 11-12, 14-17, 19-24, 35, 49-53, 58, 60-65 and 67-70 under 35 U.S.C. § 103.

As indicated above, claims 11, 49-51, 67 and 69-70 have been amended to make explicit what is implicit in the claims. Additionally, claims 15-17, 23, 35, 52 and 68 have been amended for inadvertent errors. The amendments are unrelated to a statutory requirement for patentability and do not narrow the literal scope of the claims.

Claims 11-12, 14-17, 19-20, 23-24, 35, 49-53, 55-58, 60-61, 64-65 and 67-70 were rejected under 35 U.S.C. § 103 as being unpatentable over *Hashimoto, et al.* (U.S. Patent No. 6,111,604) in view of *Kato* (U.S. Patent No. 6,148,031), *Riek, et al.* (U.S. Patent No. 5,987,179) and ISO/IEC 11172-1.

Hashimoto, et al. appears to disclose an image data compression/expansion circuit 12 used to encode and decode images using known image compression methods which transform images into an out of compressed formats such as GIFF, JPEG, MPEG or any other known image compression method (column 6, lines 62-66). Figure 11 illustrates the process for capturing and storing video and audio information. After starting, the user presses a shutter release button 124 and a single picture along with associated audio is captured and stored in step 252. Step 254 then compresses the image and audio. Separate image and audio files are then written into a memory card 16 in step 256. Subsequently, a relation file which describes the association of the image and audio files is written or updated in step 258 (column 9, lines 46-54).

Thus, *Hashimoto, et al.* merely discloses a compression/expansion circuit 12 using a single compression method. Nothing in *Hashimoto, et al.* shows, teaches or suggests encoding

using a first encoding method when capturing still picture data without audio data and encoding a picture signal with a second encoding method when capturing still picture data with audio data and moving picture data with audio data as claimed in claims 11, 35, 49-52 and 67-70. Rather, *Hashimoto, et al.* only discloses using a single encoding method.

Kato appears to disclose when an operation keyboard 32 issues a continuous image taking command, an image compression/decompression circuit 18 compresses the output of the camera signal processor circuit 16 and the compressed information is stored in a first memory 20. When a still image taking request is input during the continuous image taking, the system control circuit 26 tags with a still image taking flag the corresponding frame of the compressed image information and stores them in a first memory. Upon the end of the continuous image taking, the system control circuit 26 reads the series of still images from the first memory 20, re-compresses them by the image compression/decompression circuit 18 while sequentially taking inter-frame correlation (Col. 3, lines 41-58).

Thus, *Kato* only discloses continuous image taking or still image taking. Nothing in *Kato* shows, teaches or suggests encoding a picture signal with a first encoding method when capturing still picture data without audio data and encoding the picture signal with a second encoding method when capturing still picture data with audio data and moving picture data with audio data as claimed in claims 11, 35, 49-52 and 67-70. Rather, *Kato* only discloses continuous image taking or still image taking.

Furthermore, *Kato* merely discloses that at the end of the continuous image taking the system control circuit 26 reads the series of still images from a first memory 20, recompresses them by an image compression/decompression circuit 18 while sequentially taking inter-frame correlation. Thus, nothing in *Kato* shows, teaches or suggests encoding a picture signal received

from a photographing means corresponding to a second encoding method when capturing (a) still picture data with audio data and (b) moving picture data with audio data as claimed in claims 11, 35, 49-52 and 67-70. Rather, *Kato* only discloses re-compressing images from a memory 20 after (at the end of) continuous image taking.

Applicants respectfully traverse the Examiner's statement that it would be obvious to modify the camera of *Hashimoto, et al.* to re-encode pictures having a temporal aspect, such as pictures with associated sound, as inter-frame encoded images after encoding is taught by *Kato* since *Kato* states in column 2, lines 16-34 that such a modification would enable final recording to be achieved with higher compression. Applicants respectfully point out that column 2, lines 16-34 is directed to moving pictures only. Furthermore, the claimed invention does not "re-encode" pictures. Also, nothing in *Kato* shows, teaches or suggests encoding picture signals received from a photographing device/means with a second encoding method when capturing still picture data with audio data as claimed in claims 11, 35, 49-52 and 67-70. Re-encoding in *Kato* is for still pictures without audio. Furthermore, the "re-encoding" in *Kato* are for picture signals stored in a memory and thus are not received from a photographing device/means.

Riek, et al. appears to disclose a method and apparatus for encoding a high-fidelity still image in a MPEG bit stream (column 3, lines 46-47). Motion/still camera 10 includes a still button 22 for selecting a video frame for encoding as a still image (column 4, lines 14-26). MPEG encoder 30 is controlled by logic and control circuit 32 which receives inputs from quality selector 18, the video record button 20 and the still select button 22 (column 4, lines 38-41).

Thus, *Riek, et al.* only discloses recording still images without audio or video images. Nothing in *Riek, et al.* shows, teaches or suggests encoding picture signals received from a

photographing device/means with a first encoding method when capturing still picture data without audio data and encoding the picture signal received from the photographing means with a second encoding method when eapturing still picture data with audio data and moving picture data with audio data as claimed in claims 11, 35, 49-52 and 67-70. Rather, *Riek, et al.* only discloses that when a still select button 22 is pressed, encoding the image as a still image without audio using the MPEG encoder (*i.e.* still images without audio and moving images with audio are both encoded by MPEG encoder).

Furthermore, since nothing in *Riek, et al.* shows, teaches or suggests capturing still picture data with audio data, nothing in *Riek, et al.* shows, teaches or suggests how to generate the I, P or B picture data for still picture data with audio data as claimed in claims 11, 35, 49-52 and 67-70. Rather, *Riek, et al.* only discloses how to encode still picture data without audio data.

ISO/IEC 11172-1 at section 1-A6.3 merely discloses multiplexing video packs and audio by interleaving one audio pack in every six to seven video packs.

Thus, ISO/IEC merely discloses how to multiplex moving images containing both video and audio. Nothing in ISO/IEC shows, teaches or suggests how to multiplex still picture data with audio data as claimed in claims 11, 35, 49-52 and 67-70. Rather, ISO/IEC is only directed to multiplexing video (moving pictures) with audio.

The Examiner takes Official Notice that it is known in the art for audio and video packs to be correlated in a 1:1 ratio and cites *Tanaka* (EP 843470). *Tanaka* similarly only discloses a lock mode for a video signal. Nothing in *Tanaka* shows, teaches or suggests still picture data with audio data as claimed in elaims 11, 35, 49-52 and 67-70.

Applicants respectfully submit that the Examiner is only selecting bits and pieces of references without considering the remaining teaches of those references which would lead away

from the claimed invention. As the Courts have stated *In Re Wesslau,* 147 USPQ 391, 393 (CCPA, 1963) quoted with approval and *In Re Hedger*, 228 USPQ 685, 687 (CAFC, February 1986): "It is impermissible within the framework of 35 U.S.C. § 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of the other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."

As stated in the Court of Appeals for the Federal Circuit in *Gore v. Garlock*, 220 USPQ 303, 312-313 (CAFC 1983), cert. denied: "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

A combination of the references would merely suggest to store video files and audio files separately and to have a relation file describing the correspondence between the video and audio files as taught by *Hashimoto, et al.*, when still images are taken (without audio) to recompress them as taught by *Kato*, to use a MPEG encoder to encode the still images (without audio) as taught by *Riek, et al.*, to multiplex audio and video as taught by ISO/IEC and for video signals having a lock mode as taught by *Tanaka.* Thus, nothing in the combination of the references shows, teaches or suggests (a) encoding picture signals received from a photographing means/device with a first encoding method when capturing still picture data without audio data, (b) encoding picture signals received from the photographing means/device with a second encoding method when capturing still picture data with audio data and moving picture data with audio data and (c) when multiplexing still picture data and audio data, a time period for the encoding P or B picture data is the same as the time period of the encoded audio data as claimed

in claims 11, 35, 49-52 and 67-70. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 11, 35, 49-52 and 67-70 under 35 U.S.C. § 103.

Claims 12, 14-17, 19-20, 23-24, 53, 55-58, 60, 61, 64-65 recite additional features. Applicants respectfully submit that the claims would not have been obvious within the meaning of 35 U.S.C. § 103 over *Hashimoto, et al.*, *Kato*, *Riek, et al.*, ISO/IEC and Official Notice at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 12, 14-17, 19, 20, 23-24, 53, 55-58, 60-61, and 64-65 under 35 U.S.C. § 103.

Claims 21-22 and 62-63 were rejected under 35 U.S.C. § 103 as being unpatentable over *Hashimoto, et al.*, *Kato*, *Riek, et al.* ISO/IEC and further in view of *Ejima, et al.* (U.S. Patent No. 6,327,423).

Applicants respectfully traverse the Examiner's rejection of the claims under 35 U.S.C. § 103. The claims have been reviewed in light of the Office Action, and for reasons which will be set forth below, Applicants respectfully request the Examiner withdraws the rejection to the claims and allows the claims to issue.

As discussed above, since nothing in the combination of the primary references shows, teaches or suggests the primary features as claimed in claims 11 and 52, Applicants respectfully submit that the combination of the primary references with the secondary reference to *Ejima, et al.* will not overcome the deficiencies of the primary references. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 21-22 and 62-63 under 35 U.S.C. § 103.

Thus, it now appears that the application is in condition for a reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested.

CONCLUSION

If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is requested to contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge to our Deposit Account No. 50-0320.

Respectfully submitted,

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